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OFFICE OF PETITIONS

In re Application of :
Dygert, et al. :
Application No. 09/976,038 :
Filed: 15 October, 2001 :
Attorney Docket No. 1617.1001CIP :
(MBHB 03-622A) :

ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 27 September, 2004.

The Office regrets the delay in addressing this matter.

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- there are three related but certainly separate applications, to wit:
 - the parent 09/227,086 (the ‘086 application) (filed 5 January, 1999, and issued as Patent No. 6,304,523 on 16 October, 2001 (the ‘523 patent));
 - the instant application (a continuation-in-part of the parent) 09/976,038 (the ‘038 application) (filed 15 October, 2001); and
 - the re-issue application (of the ‘523 patent) 10/687,510 (filed 16 October, 2003) (the ‘510 application);
- Petitioner Joseph P. Herndon (Reg. No. 50,469) avers that the instant ‘038 application was filed in error and without deceptive intent (by prior Counsel) with only three co-inventors listed (to wit: Timothy W. Dygert (Mr. Dygert), Sethu K. Madhavan (Mr. Madhavan), and Gerard V. Talatinian (Mr. Talatinian), and an oath/declaration signed by Messrs. Dygert, Madhavan and Talatinian was filed in the application;
- however, Petitioner avers that he has come to know that Scott A. Jones (Mr. Jones) and Douglas M. Keenan (Mr. Keenan) also were co-inventors, and to this end Petitioner has sought to obtain the signatures of all five co-inventors on a new oath/declaration and statements from all inventors as to the lack of deceptive intent, and thereby also obtain a correction of inventorship under 37 C.F.R. §1.48 (filed separately and before the Examiner);
- two pieces of correspondence (dated 28 May, 2004, and 9 June, 2004, respectively) from Petitioner to Mr. Keenan set out Petitioner’s efforts and forwarded to Mr. Keenan a copy of the re-issue application (the ‘510 application) and an oath/declaration for that application;
- however, there is no evidence in the record that Petitioner transmitted to Mr. Keenan a copy of the instant application;
- two pieces of correspondence—one unsigned and undated but submitted with a copy of the envelope evidencing Mr. Keenan’s return address label and the other signed by Mr. Keenan and dated “9 June 04” both contain in one form or another the statement: “I . . . have no interest in signing anything”;

- an inquiry to Petitioner at the time this matter was taken up in the Office of Petitions on 17 March, 2004, as to whether he possessed documentation evidencing that a copy of the entire instant application—description, claims, abstract and drawing—was sent to Mr. Keenan and Petitioner's response was that a copy of the instant application had not been sent.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

- (1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

When one alleges a refusal of the inventor to sign the application papers, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who, *inter alia*, presented the inventor with the application papers and/or to whom the refusal was made.

The commentary at MPEP §409.03(d) provides:

409.03(d) Proof of Unavailability or Refusal

INVENTOR CANNOT BE REACHED

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 C.F.R. §1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 C.F.R. §1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 C.F.R. §1.47. 37 C.F.R. §1.43 may be available under these circumstances. See MPEP §409.02. Such a petition under 37 C.F.R. §1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

REFUSAL TO JOIN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 C.F.R. §1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP §106. It is reasonable to require that the inventor be presented with the application papers before a

petition under 37 C.F.R. §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 C.F.R. §1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Thus, not only must a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application—and evidence of that transmittal submitted—but also a reasonable effort must be made to ascertain a current or last known address, and the petition (with fee) must state over the signature and registration number of the Petitioner the last known address and, if appropriate, evidence of the due diligence effort ascertaining same.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47

applicant is required.¹

CONCLUSION

Petitioner acknowledges that he has not addressed the instant application with or presented the entire application to Mr. Keenan. Whatever Mr. Keenan's expressed position as to another application, the instant application is a separate matter and must be attended to as such. The procedure is not an exercise in futility, but, rather, a methodology of protecting due process and potential property-right interests.

Therefore, the instant petition hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents²
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306 (IFW Formal Filings)
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

¹ See: MPEP 409.03(b).

² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.